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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,047	04/10/2001	Mitsunori Tsujino	57454-067	8301
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McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096		EXAMINER BYLCIW, STEPHEN		
		ART UNIT 3623 PAPER NUMBER		

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/829,047

Applicant(s)

TSUJINO, MITSUNORI

Examiner

Stephen Bylcw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-14 and 16 is/are rejected.
- 7) ☒ Claim(s) 8 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This non-final office action is in response to the application filed in the United States on April 10, 2001 and in Japan on November 14, 2000. Claims 1 through 16 are pending in this application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 1, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by the National Semiconductor website (www.national.com) on or before 10/13/1999.**

Regarding claims 1 and 10, National Semiconductor teaches a marketing method comprised of managing data using an identification number per product, transmitting grading information via a network, registering new members, receiving purchase orders, and reflecting user reaction for products ordered (i.e., National Semiconductor provided various website page content: The "Master Selection Guide" pages managed data using a product specific part number and allowed users to submit purchase orders. The data sheet pages contained grading information that could be transmitted to customers via a network. The home page allowed new customers to register as new users and reflect a reaction for products ordered.) See Exhibit 1 to view a data matrix organized

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by part number and "Buy Now" links to submit purchase orders. See Exhibit 2 to view grading information (in this case static, dynamic, functional, and switching tests) for a wideband variable-gain amplifier that could be transmitted to customers. See Exhibit 3 for the "sign-on" link allowing customers to register as new users and a "feedback" link to reflect a reaction for products ordered.

Regarding claim 9, National Semiconductor teaches a marketing device implementing a marketing method to reflect the user's reaction and receive an inquiry from a user terminal (i.e. National Semiconductor provides a feedback link on its webpage to allow it to receive feedback or inquiries). See Exhibit 3.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 2-4, 6, 7, 11-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over National Semiconductor in view of Kotler (page 293-296 in "Marketing Management" Eighth Edition, published in 1994 with an ISBN of 0-13-722851-1).**

Regarding claims 2 and 11, National Semiconductor shows a marketing method and an associated device, but does not specifically show a reliability levels and costs in

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accordance to conducted tests. Kotler shows the marketing concept for creating different versions of the product having optional tests and associated reliabilities and costs in an analogous art for the purposes of competitive advantage. On page 295, paragraph 13, lines 1 through 7, Kotler discloses, "Features are characteristics that supplement the product's basic functioning. Most products can be offered with varying features. The starting point is a stripped-down, or "bare-bones," version of the product. The company can create additional versions by adding extra features... the [seller] needs to decide which features to make standard and which to make optional." It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide different testing options and associated costs for products offered on National Semiconductor's website because of competitive advantage.

Regarding claims 3 and 12, Kotler shows a shows the concept of product differentiation for competitive advantage, but does not show managing data by editing a test-related file and product information file. National Semiconductor's website shows a test-related file that could be edited in an analogous art for the purpose of informing the customer about product features and capabilities. The data sheet is shown in Exhibit 2 and it has an identification number and related product test information that could be edited. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to edit the data sheet that already has identification number, test information and associated grading information per product because of efficiency of communication.

Regarding claim 4, Kotler shows a shows the concept of product differentiation for competitive advantage, but does not show said step of transmitting grading information includes the step of retrieving a product information file in response to a request from a user terminal. National Semiconductor shows product grading information in a file that could be retrieved and transmitted in an analogous art for the purposes of informing the customer about product features and capabilities. For example, National Semiconductor (Exhibit 2) provides a data sheet having identification number and information concerning conducted test(s) registered to the product that could be retrieved in response to a request from a user terminal. It would have been obvious to one skilled in the art at the time the invention was made to take the product differentiation options taught by Kotler and transmit the grading information by retrieving an updated version of the National Semiconductor data sheet in response to a request from a user terminal because of efficiency of communication.

Regarding claims 6 and 13, Kotler shows a shows the concept of product differentiation for competitive advantage and National Semiconductor shows a marketing method and an associated device. Both references are silent regarding the editing of purchase product and purchase history files when receiving a purchase order. Official notice is taken that the editing of purchase product and purchase history files is old and well-known in the art to efficiently track the transfer of products from buyer to seller and to record customer purchases. It would have been obvious to a person of

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ordinary skill in the art at the time the invention was made to modify a marketing method and associated device offering products with various testing options to include the editing of purchase product and purchase history files because of efficiency.

Regarding claims 7 and 14, Kotler shows a shows the concept of product differentiation for competitive advantage and National Semiconductor shows a marketing method and an associated device. Both references are silent regarding retrieving and reviewing relevant product history within the warranty period after the receipt of a customer complaint. Official notice is taken that retrieving and reviewing relevant product history within the warranty period is old and well-known in the art to enable the seller of the product to determine both liability and whether the product historically meets customer's needs. It would have been obvious to one skilled in the art at the time the invention was made to modify a marketing method and associated device offering products with various testing options to include the retrieval and review of relevant product history within the warranty period because of liability and customer satisfaction efforts.

Regarding claim 16, Kotler shows the concept of product differentiation for competitive advantage, but does not show the process of receiving inquiries from user terminals and applying a user identification number. National Semiconductor in Exhibit 3 shows a web page with a feedback link in an analogous art for the purpose of allowing a user terminal to send inquiries to the seller. It would have been obvious to a person of

ordinary skill in the art at the time the invention to take the product differentiation options taught by Kotler and modify a marketing method and associated device to include a feedback link that enabled a user terminal to submit an inquiry that would be assigned a user identification number.

**6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over National Semiconductor in view of Kotler (page 293 in “Marketing Management” Eighth Edition, published in 1994 with an ISBN of 0-13-722851-1) and further in view of Seybold (page 88-103 in “Customers.com – How To Create A Profitable Business Strategy For The Internet and Beyond” first edition published in 1998 with an ISBN of 0-8129-3037-1).**

Regarding claim 5, Kotler shows a shows the concept of product differentiation for competitive advantage and National Semiconductor shows a marketing method and an associated device. Both references are silent regarding a method of marketing wherein users register as members and are assigned a unique identification number as information about them is edited in a file. Seybold (page 93, paragraph 4, lines 3-9) shows National Semiconductor provided opportunities for [customer] design engineers to register as users, fill out on-line surveys, and have their identifying information sent to salesperson assigned to their account. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify a marketing method and associated marketing device with different testing options to register customers and



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assign them unique identification numbers because of the need to accurately record the customer interaction.

***Allowable Subject Matter***

7. Claims 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are considered pertinent.

a) U.S. Patent 5,970,475 teaches an electronic procurement system and method of initiating and consummating sales transactions of goods and/or services by buyers and suppliers.

b) U.S. Patent 4,799,156 teaches an online system for processing business transactions with an interactive market management system (IMMS).

c) U.S. Patent 6,785,805 teaches an online system for configuring and building systems and providing systems integration for the test, automation and measurement environment.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Bylciw whose telephone number is 571-272-8125. The examiner can normally be reached on weekdays, 8AM-5PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB: 5-5-2005



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